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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/921,020
Filing Date: August 02, 2001
Appellant(s): CHASTAIN ET AL.

YEE & ASSOCIATES, P.C
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 28, 2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments

The appellant's statement of the status of amendments contained in the brief is correct. The Specification was amended in response to the Final Office Action. The Appellant amended the specification in order to avoid the 35 U.S.C. 112 REJECTION (i.e., all the independent claims contain subject mater which was not described in the Specification). The amendment has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 1 to 7 and 9 to 16 and 18 to 21 are rejected under 35 U.S.C. 102 (e) as being anticipated by Graham et al (US Pat No. 6,457,026).

(7) Argument

The Appellant presents arguments regarding the rejection of Claims 1 to 7 and 9 to 16 and 18 to 21 by Graham et al (US Pat No. 6,457,026).

(8) Claims Appendix

The copy of the appealed claims contained In the Appendix is correct.

(9) Evidence Appendix

None

(10) Related Proceedings Appendix

None

(11) Prior Art of Record

6,457,026	*GRAHAM et al*	*9-2002*

(12) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

4. Claims 1-7, 9-16 and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Graham et al (US Pat No 6,457,026).

With regard to claims 1, 18 and 21:

Graham et al ("Graham") discloses a computer-implemented method for researching highlighted or annotated text in an electronically stored document (or electronic book), which contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B).

The method at least in part includes receiving a user input via an input device (Fig. 1, #36). A relevant text is preceded by a tag (tag 1002) and followed by another tag (tag 1004) (i.e., beginning and ending tags) (column 8, lines 13-51). The use of these tags facilitates the annotation mode where complete sentences are highlighted and a user identifies the selected text after the e-book is displayed (see Fig. 2B, #220,

Fig. 2C, #224, or Fig. 2D, #226, column 3, lines 56-66, column 4, lines 3-28, column 5, lines 32-50, column 8, lines 13-31).

The method also includes *automatic* web *search* process (automatically initiating a search), wherein when this web *search* process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web *search* tool such as Alta Vista ™ is employed to look on the World Wide Web for documents containing the keyword (the selected text) or key phrase (column 7, lines 46-57).

With regard to claim 2:

Graham further discloses a search for at least one item relevant to the selected text includes at least a World Wide Web document or another electronic document (column 7, lines 46-57).

With regard to claim 3:

Graham further discloses maintaining (storing) the selected text in a user profile file 516 data structure (Figs. 5, and 6A-6C, column 5, lines 13-16).

With regard to claims 4 and 12:

Graham discloses a method and system to facilitate reading a document. Graham further discloses a document display system that is easily personalizes and flexible as well (column 1, lines 47-50). Graham further discloses a pattern identification stage that looks for particular patterns (or structure) in the parsed text output of text processing stage. The particular patterns searched for are determined by the contents of user profile file 516 (Fig. 6B, column 5, lines 32-50).

With regard to claim 5:

Graham also discloses that the selected text or key phrase is a highlighted text, wherein the user may select any highlighted key phrase with the mouse (Fig. 2B, #220, column 3, lines 57-63).

With regard to claim 6:

As illustrated in Fig. 2, Graham further discloses that the highlighted text is text in a different color from unselected text, bolded text, and text with a different font type from unselected text (column 3, lines 57-63, Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226).

With regard to claim 7:

Graham further discloses that the selected text is an entire sentence (or notated passage of text) (Fig. 2C, #224) in the electronic document (or electronic book) and wherein the notated passage of text is a user created note associated with at least a portion of the electronic document (column 3, lines 57-column 4, lines 17).

With regard to claim 8:

Furthermore, as described above, Graham further discloses that the highlighted text is a highlighted passage of text in the electronic document (or electronic book) (column 4, lines 3-9, Fig. 2C, #224).

With regard to claim 9:

Graham further discloses document browser 506, receiving and viewing (or presenting) the search result to a user (Fig. 5, column 4, lines 45-column 5, lines 17).

With regard to claim 10:

Graham further discloses receiving a result is initiated using a search engine, such as, for example, a web *search* tool such as *Alta* Vista ™ is employed to look on the World Wide Web for documents containing the keyword or key phrase (column 7, lines 46-57).

With regard to claims 11 and 19:

Graham discloses a computer-implemented method for researching highlighted or annotated text in an electronically stored document (or electronic book), which contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B).

The method includes among other things, designating, or tagging the text to use in a search in a search based on a user selected beginning and ending tags of any portion of text located in an electronic document (column 8, lines 13-31); the method also includes responsive to designating the text in the electronic document to use in search, placing the text in a data structure, wherein the data structure is a search profile (column 5, lines 9-16, column 6, lines 31-45);

Preparing and transmitting (via document browser 506) the selected highlighted text to be searched by a web search tool such as Alta Vista ™ (column 7, lines 46-57).

The method further includes receiving (via document browser 506) the search result from the web search (column 7, lines 46-57).

With regard to claim 12:

Graham also includes said text includes a user created note associated with the text (column 3, lines 49-56, column 5, lines 3-8).

With regard to claim 13:

Graham further discloses that the search profile includes search criteria, such as, or example searching by concept, title, name or keyword (see Fig. 8, column 6, lines 62-column) 7, lines 12).

With regard to claim 14:

As illustrated in Figs. 2A-2D, 3, 4, 9A and 9B, Graham further discloses the electronic document is at least one of an electronic book and a web page.

With regard to claim 15:

Graham further discloses downloading the result from the search engine, that is, the method enables the document browser 506 to retrieve (download) the results of researched selected text (column 7, lines 46-57).

Graham also discloses displaying the result from the search engine, that is, the method also enables the document browser 506 to display the results of researched selected text (Figs. 5, and 6A through 6C, column 5, lines 1-16; column 5, lines 17-65).

With regard to claim 16:

Graham also discloses that designation or marking of the text is made by highlighting the text in the electronic document (Fig. 2B, #220, column 3, lines 57-63).

With regard to claim 20:

Graham discloses a data processing system (Fig. 1, #10) comprising: a bus system (12); a communication unit (40) connected to the bus system; a memory (16) connected to the bus system, wherein the memory includes a set of instructions.

Graham further discloses a processing unit (14) connected to the bus system, wherein the processing unit executes the set of instruction to receiving a user input (30 and 36) selecting the text from the electronic book to form selected text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226). A relevant text is preceded by a tag (tag 1002) and followed by another tag (tag 1004) (i.e., beginning and ending tags) (column 8, lines 13-51).

Graham also discloses automatic web search process (automatically initiating a search) (column 7, lines 46-57), wherein when this web search process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista ™ is employed to look on the World Wide Web for documents containing the keyword (the selected text) or key phrase (column 7, lines 46-57).

(13) Response to Arguments

5. The Appellants' arguments presented in the Brief have been fully considered but they are not persuasive.

With regard to the rejected independent claims 1, 18, 20, and 21:

The Appellant argue "Graham does not teach or suggest *receiving a user input selecting the text from an electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed*." (claim 1, Brief, page 12, lines 1-4). In contrast to the Appellants argument Graham teaches a method in a data processing system (Fig. 1) for researching an

electronically stored document (electronic book) which contains a plurality of pages (Figs. 2A-2D, 3, 4, 9A, 9B, etc). The method at least includes the "*receiving*" step of representative claim 1. For example, Graham teaches "receiving user input indicating selection of a set of one or more concepts from said plurality of concepts." (column 9, lines 34-35). Graham also teaches the known process (also admitted by Appellant, see Amendment to the Specification entered on Feb 7, 2005) of selecting a portion of text by tagging, i.e., clicking a beginning point and an ending point of any portion of text in the electronic book that is of interest to a user (also see Graham, column 8, lines 13-51). Graham further teaches (column 9, lines 36-37, column 3, lines 56-66, column 4, lines 10-28) and illustrates (Figs. 2B, #220, 2C, #224, 2D, #226, etc) the selected text is identified (marked or highlighted) by a user after the electronic document is displayed.

Furthermore it should be understood that selecting of a portion of text within the electronic document by the user is only possible when the electronic book is available and shown on the display (e.g., Figs. 2A, also see the last two steps of claim 1 of Graham).

The Appellants argue, "Graham does not teach or suggest automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input." (Representative claim 1, Brief, page 12, lines 5-6). In contrast to the Appellants' argument, Graham teaches in response to the user input (e.g., clicking a key word), the method of the data processing system automatically performs a web search process (automatically initiating a search) for at least one item relevant to the selected text (column 7, lines 46-57, column 5, lines 32-58).

The Appellants further argue, "Graham teaches highlighting keyword in an electronic document based on the contents of a user profile." In contrast to the Appellants' argument, Graham is not limited or bounded to a user profile operation, Graham teaches that a user may enable or disable the operation of the user profile updating (Fig. 8, #836 check box, column 7, lines 46-57). Accordingly, it is a choice given to the user, i.e., Graham permits the user to enable or disable the profile operation (via check box 836).

The Appellants further argue, "In Graham, the electronic book is highlighted based in response to opening the electronic book." In contrast to the Appellants' argument, as the Examiner points out above, the electronic book is NOT necessary highlighted based in response to opening the electronic book because it (highlighting) depends on the user profile setup, i.e., enabled or disabled profile operation (column 7, lines 46-57). Thus, in response to the opening of electronic document, the displayed texts that are relevant to a user are not necessarily highlighted automatically.

The Appellants also argue "Graham's web *autofetch* feature only searches for keywords in a user profile." Again, the Examiner disagrees because all depends on the user profile selected option, if disabled, the web *autofetch* searches for keyword anywhere in the electronic document (column 7, lines 46-57).

The Appellants also argue "Graham provides no ability for a user to select a portion of a displayed electronic book, by tagging a beginning point and an end point, and then initiating a search for an item relevant to the selected portion of text." In

contrast to the Appellants' argument, Graham teaches selecting by tagging and initiating a search for the selected portion (column 5, lines 32-58, Figs. 9A and 9B).

With regard to the rejected independent claims 11 and 19:

The Appellants also argue "Graham does not teach or suggest designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document." In contrast to the Appellants' argument, Graham teaches designating any portion of text to be used in a search based on a user selected beginning point and ending point of the text located in an electronic document (column 8, lines 13-31, column 5, lines 9-16, column 6, lines 31-45).

The Appellants further argue, "Graham only teaches automatically searching for keywords in a user profile." Again the Examiner disagrees because automatically searching for key words in a user profile is not the only option taught by Graham, Graham also teaches disabling the profile operation to search for keywords anywhere in the electronic document (column 7, lines 46-57, column 5, lines 32-58).

With regard to the rejected dependent claims 7 and 12:

The Appellants argue "Graham does not teach, suggest or mention creating notes for an electronic document or using the text from a note in a search." In contrast to the Appellants' argument, Graham teaches creating notes for an electronic document (e.g., Fig. 2C, #224). Graham teaches that the selected text is an entire sentence (or notated passage of text) (Fig. 2C, #224) in the electronic document and wherein the notated passage of text is a user created note associated

with at least a portion of the electronic document (column 3, lines 57-column 4, lines 17).

(14) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

USPTO, WASHNGTON, DC
July 20, 2005

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